

### III. REMARKS

Claims 1-16 are pending in this application. By this response, no claims have been amended. Applicant does not acquiesce in the correctness of the rejections and reserves the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicant reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

In the Office Action, claims 1-16 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Yoshida (U.S. Patent No. 6,801,546 B1), hereafter “Yoshida,” in view of Thompson (U.S. Patent No. 6,985,494). With regard to the rejection, Applicant asserts that the cited references fail to teach each and every feature of the claimed invention. For example, with respect to independent claims 1, 4, 6, 9, 12-13 and 15-16, Applicant submits that the cited references fail to teach or suggest converting said electronic mail data converted into said image form back into electronic mail data in the electronic mail format. Instead, Thompson teaches that “...a first converter that converts said electronic mail data of said incoming transmission to binary facsimile data when it is determined that said incoming transmission was sent from an IP client source.” Col. 21, lines 40-43. In Thompson, facsimile data is transmitted over an IP network to a destination facsimile device, wherein the facsimile data originates as a standard facsimile transmission from a source facsimile device or as an electronic mail transmission from an IP client source device. (Col. 21, lines 10-15.) In the case that the facsimile data originates as electronic mail data, a first converter converts the electronic mail data to binary facsimile data. (Col. 21, lines 40-43). However, nowhere does Thompson teach a message that begins as an

email, is converted to facsimile, and ends up as an email after being transmitted over a switched line. As such, both Yoshida and Thompson fail to teach the features of the claimed invention. Accordingly, Applicant respectfully requests that the Office withdraw its rejection.

Furthermore, Applicant submits that there is no suggestion or motivation to combine the teachings of Thompson, with the facsimile/internet transmission system disclosed generally by Yoshida. While Thompson discloses generally a method for managing facsimile communications over the internet using conventional telephony communications equipment, it is incomprehensible why Thompson or Yoshida, or a person of ordinary skill in the art, would consider an invention, as disclosed in Thompson, that teaches facsimile data originating as a standard facsimile transmission that is received over an IP network and converted to a standard facsimile protocol signal for communication via facsimile, when they are faced with the problem of transmitting a document that is originally in a facsimile format, is transmitted via facsimile, is converted into an email, is sent to another facsimile machine via email, is converted into a facsimile, and is transmitted via facsimile, as taught by Yoshida. As a result, Applicant submits that there is no motivation or suggestion to combine the cited references and respectfully request the withdrawal of the rejection.

With respect to dependent claims 2-3, 5, 7-8, 10-11, and 14, Applicant herein incorporates the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

#### IV. CONCLUSION

In addition to the above arguments, Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

Date: November 9, 2006

/Darrell L. Pogue/  
Darrell L. Pogue  
Reg. No.: 57,878

Hoffman, Warnick & D'Alessandro LLC  
75 State Street 14<sup>th</sup> Floor  
Albany, New York 12207  
(518) 449-0044  
(518) 449-0047 (fax)